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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/617,528	07/10/2003	Nigel Howard Julian Brown	AUS920030295US1	3557
35525	7590	03/25/2008		
IBM CORP (YA) C/O YEE & ASSOCIATES PC P.O. BOX 802333 DALLAS, TX 75380			EXAMINER KARDOS, NEIL R	
			ART UNIT 3623	PAPER NUMBER
			NOTIFICATION DATE 03/25/2008	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ptonotifs@yeeiplaw.com

Office Action Summary	Application No. 10/617,528	Applicant(s) BROWN ET AL.	
	Examiner Neil R. Kardos	Art Unit 3623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>7/10/03</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This is a non-final first Office action on the merits. Currently, claims 1-20 are pending.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. **Claims 15-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

Claims 15-20 recite *a computer program product in a computer readable medium comprising instructions*. The limitations as claimed are non-functional descriptive material because they do not cause a computer to execute the instructions. Because instructions on a computer readable medium could simply constitute text, the limitations as claimed do not produce a useful, concrete, and tangible final result without executing the instructions on a computer.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1, 3-10, 12-15, and 17-20 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. pre-grant publication number 2005/0043985 to Gillespie (“Gillespie”).

Claims 1, 9, 10, & 15: Gillespie discloses a method, system (see paragraph 36: lines 31-34 for system components), and computer program product (see id.) in a data processing system for providing a consulting assessment environment, the method comprising:

- receiving data about a business through a questionnaire, wherein the questionnaire is defined by a data template (see paragraph 36: lines 10-23, disclosing a survey system to present questions and receive responses regarding a business; paragraph 37, disclosing customizing the survey questions);
- computing at least one assessment score based on formulas in an assessment framework template (see paragraph 38: lines 1-15, disclosing evaluating responses and generating a score based on the responses; paragraphs 43-51, disclosing specific calculations)
- determining an appropriate action based on the at least one assessment score and a suggested actions template (see paragraph 38: lines 8-15, disclosing providing the user with a recommendation; paragraph 43); and
- reporting results based on the at least one assessment score and the appropriate action in accordance with a report template, wherein the assessment framework template and the suggested actions template encode business-related domain knowledge (see paragraph 38: lines 8-30, disclosing reporting results to users; paragraph 52; paragraph 56) including at least one of best practices, business

consultant expertise, and business goals (see paragraph 37: disclosing customizing a survey and evaluation based on an administrator's input).

Claims 3, 12, & 17: Gillespie discloses identifying benefits and risks based on the at least one assessment score and the appropriate action (see paragraphs 39, 52, and 56, disclosing determining the merits and costs; paragraph 54).

Claims 4, 13, & 18: Gillespie discloses consolidating portions of the results together for further analysis (see paragraph 38: lines 15-19; paragraphs 42 and 54).

Claims 5, 14, & 19: Gillespie discloses providing an interface for a client to conduct a self-assessment (see paragraph 36: lines 31-34).

Claim 6: Gillespie discloses wherein the data template includes at least one of interview questions (see paragraph 37), weighing factors (see paragraph 37), desired states, benefit descriptions (see paragraph 54), risk descriptions, suggested actions (see paragraph 42), cost areas (see paragraph 54), and terminology.

Claim 7: Gillespie discloses wherein the assessment framework template includes at least one of scoring information (see paragraphs 43-51), calculations (see id.), suggested actions logic (see id.), benefit and risk logic (see id.), user feedback (see id.), and user input (see id.).

Claims 8 & 20: Gillespie discloses wherein at least one of the data template, the assessment framework template, the suggested actions template, and the report template are made inaccessible to at least one user (see paragraph 37, disclosing allowing an administrator to customize surveys; paragraph 38: lines 25-30, disclosing “designated” users and “authorized” employees).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. **Claims 2, 11, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gillespie in view of U.S. pre-grant publication number 2002/0173999 to Griffor et al (“Griffor”).**

Claims 2, 11, & 16: Gillespie does not explicitly disclose:

- determining a current state of the business based on the data;
- identifying a desired state for the business using the assessment framework template and the suggested actions template; and
- performing a gap analysis between the current state of the business and the desired state of the business to determine the appropriate action to achieve the desired state for the business.

Griffor teaches brining the current state of a business into alignment with its goals and purposes via a consulting process that determines appropriate actions required for that alignment (see paragraphs 15-19).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to apply the teachings of Griffor to the invention of Gillespie in order to take actions that would align a business with its goals. One of ordinary skill in the art would have been

Art Unit: 3623

motivated to do so for the benefit of more efficient management of opportunities (see Gillespie, paragraph 1).

Additional Prior Art

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. patent number 5,084,819 to Dewey et al, directed to a data collection, analysis, and response system and method.

U.S. patent numbers 5,960,419; 5,963,931; 5,978,784; and 6,009,420 to Fagg et al, directed to a computer-assisted decision management system.

U.S. patent number 5,717,865 to Stratmann, directed to a method for assisting individuals in decision making processes.

U.S. pre-grant publication number 2003/0158800 to Pisello et al, directed to financial evaluation of information technology projects.

U.S. pre-grant publication number 2003/0126049 to Nagan et al, directed to assessing technological and legal management risks.

U.S. pre-grant publication number 2004/0068429 to MacDonald, directed to strategic organization plan development.

U.S. pre-grant publication number 2004/0172317 to Davis et al, directed to improving process and outcomes in risk assessment.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Neil R. Kardos whose telephone number is (571) 270-3443. The examiner can normally be reached on Monday through Friday from 9 am to 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on (571) 272-6729. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Neil R. Kardos
Examiner
Art Unit 3623

NRK
3/13/08

/Beth Van Doren/
Primary Examiner, Art Unit 3623